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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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20350	7590	08/18/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			YANG, CLARA I	
			ART UNIT	PAPER NUMBER
			2635	

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/940,767

Applicant(s)

LUND, ARNOLD M.

Examiner

Clara Yang

Art Unit

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5,6,9-11,13,15,17-19,21,22 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3,5,6,9,18,22 and 25 is/are allowed.
- 6) ☒ Claim(s) 10,11,13,15,17,19, 21 and 24 is/are rejected.
- 7) ☒ Claim(s) 26-28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Response to Arguments***

1. Applicant's arguments filed on 13 June 2005 with respect to claim 10 have been fully considered but are not persuasive. On page 7, the applicant states that Gorday and LaPorta fail to teach or suggest a voice message from a pagee. However, as shown in Fig. 3, LaPorta teaches that Thomas (pagor) sends a message via pager 50a to Paul (pagee), who receives the message via telephone 62 (see Col. 5, lines 53-62 and Col. 6, lines 18-22). Paul then uses telephone 62 to respond to the message, and Thomas receives Paul's response ("Burger King") via pager 50a. LaPorta discloses that the two-way wireless messaging system has a translator for translating messages into different formats (see Col. 11, lines 28-35), thereby enabling Paul to receive a voice message via telephone 62. Because Paul uses telephone 62 to respond to Thomas's message, it is understood that Paul's response is a voice message ("Burger King") that is routed to a translator via distribution server 116 and translated into a page message (i.e., second format).

***Allowable Subject Matter***

2. Claims 1-3, 5, 6, 9, and 22 are allowed.
3. Claims 18 and 25 are allowed.
4. Claims 26-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Claim Objections***

5. Claim 21, which is substantially similar to claim 17, is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous

Art Unit: 2635

claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 17 already calls for a "computer-readable medium having computer-executable instructions for performing the computer-implementable method for paging from the pagor to the pager".

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10, 11, 13, 15, 17, 19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorday et al. (US 5,703,570) in view of LaPorta et al. (US 5,974,300).

Referring to claims 10 and 15, Gorday discloses a two-way wireless messaging system 10 as shown in Fig. 1. Regarding claim 10, Gorday teaches a paging method wherein system controller 102 performs the steps of: (a) receiving a message intended for a portable subscriber unit (PSU) 106 from a remote sender (i.e., "pagor") at a first location via telephone 101, facsimile machine 120, or messaging terminal 122 (see Col. 3, lines 50 - 55 and 60 - 65); (b) sending the page wirelessly to the intended PSU 106 (i.e., "pager") via transmitter/receiver 103 (see Fig. 1 and Col. 5, lines 11 - 16); (c) determining if a predetermined time limit for a response, such as an acknowledgment (ACK) or a non-acknowledgment (NACK), from PSU 106 has been exceeded (see Fig. 4, step 416 and Col. 10, lines 14 - 32 and 46 - 52); (d) converting the outbound message received from a message input device to a page message (see Col. 3, lines 60 - 65 and Col. 5, lines 11 - 16); and (e) notifying PSU 106 via a second message (or activating a message-waiting

Art Unit: 2635

indicator) that a first message is being stored as required in claim 1 (see Fig. 4, steps 416, 430, and 424; and Col. 10, lines 14 - 25 and 46 - 55). Per Gorday, PSU 106 is one of several types of devices, including two-way pagers (see Col. 5, lines 34 - 35). Gorday also imparts that when the intended PSU 106 receives an outbound message transmitted by system controller 102, a user (or "pagee") can use PSU 106 to generate and transmit an inbound response back to system controller 102. System controller 102's message handler function identifies the inbound response as having been generated by the user specifically in response to the outbound message and generates another message that is sent to the originator (i.e., "pagor") of the outbound message to notify the originator that the outbound message has been acknowledged and responded to by PSU 106. (See Col. 6, lines 35 - 52.) In order for a user to respond to the originator's outbound message via PSU 106, Gorday's method further includes the step of system controller 102 (f) storing information relating to the originator's communication mode that can be used to send a response to the originator via system controller 102. Though Gorday's system enables the pagor to send a voice page message to a pagee (see Col. 3, lines 62-67) and the pagee to send an acknowledgment to the pagor via PSU 106 (see Col. 3, lines 65-67 and Col. 4, lines 1-2), Gorday is silent on (1) a pagee sending a voice page message to the pagor, (2) converting the voice page message to a second format, and (3) sending the converted message to the pagor (as called for in claim 10). And though Gorday discloses that alternate means of delivery, such as voice mail or email, can be used when a page is undeliverable (see Col. 4, lines 53 - 55), Gorday is silent on the steps of storing information relating to a plurality of communication modes for the pagor that the pagee can use when returning the page (as called for in claims 15).

In an analogous art, LaPorta's method for sending a page to a recipient (or "pagee") comprises the steps of: (a) two-way message network 14 receiving a page from pager 50a, which is at a first location (see Fig. 3 and Col. 5, lines 53 - 62); (b) two-way message network 14 sending a page via air interface 57a to pager 58, which is at a second location (see Col. 5, lines 53 - 62); and (c) user agent 50 expanding or converting the page into a full message prior to sending the page (see Col. 6, lines 3 - 10). LaPorta also teaches in Figs. 7 and 8 that when a subscriber S 200 sends a message to recipients R1 202, R2 204, and R3 206 via batch server 208, batch server 208 forwards the message to messaging server 210, which contacts the user agent of subscriber 200 (i.e., UA-S 212) (see Col. 14, lines 41 - 62). Messaging server 210 contacts the user agents of the message recipients to determine the location of their corresponding messaging devices, the format in which they wish to receive the message, and their status (see Col. 14, lines 60 - 67 and Col. 15, lines 1 - 12). The user agent of recipient R3 (UA-R3) responds that its pager is off and that the message should be forwarded to message storage server 224 (see Col. 15, lines 15 - 16). Message storage server 224 (d) stores the message, and UA-R3 (e) sends a retrieval ID, thereby activating a message-waiting indicator to R3, when R3 powers on (see Col. 15, lines 44 - 51). LaPorta further teaches the step of (f) a sender's user agent storing information relating to format and filtering/forwarding criteria (or communication mode) for the page recipients to use when returning the page (see Col. 6, lines 18 - 25; Col. 7, lines 18 - 40; Col. 8, lines 17 - 18; Col. 11, lines 28 - 42; and Col. 16, lines 5 - 30). Per LaPorta, the originator's message includes an array of reply-to addresses (see Col. 14, lines 41 - 46). In light that a subscriber 40's user agent is able to forward messages as specified by the subscriber and that a subscriber can have a plurality of reply-to addresses, the user agent must store a plurality of communication modes for a subscriber. Consequently, LaPorta teaches the step of storing

Art Unit: 2635

information relating to a plurality of communication modes for the sender that the recipient can use when returning the page (as called for in claims 10 and 18). In addition, as shown in Fig. 3, LaPorta teaches that Thomas (i.e., pagor) uses pager 50a to send a message to Paul (i.e., pagee), who receives the message via telephone 62 (see Col. 5, lines 53-62); thus Thomas's message is converted from a page message to a voice message. In return, Paul uses telephone 62 to send a response ("Burger King") to Thomas's pager 50a. Because LaPorta's system includes a translator for translating messages into desired formats, it is understood that Paul's response is a voice message that is converted to a text message to be displayed on Thomas's pager 50a.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Gorday as taught by LaPorta because storing an undeliverable message in a communication mode agnostic supports multicasting without the user having to specify the communication mode and enables a user to send a message to other's message devices other than pagers (see LaPorta, Col. 2, lines 58 - 65; Col. 5, lines 53 - 62; and Col. 16, lines 47 - 49). In addition, storing a plurality an originator's communication modes can be used when a user responds to an originator's message improves the likelihood of the originator receiving the responses, thus improving radio communication system 100's performance. Finally, by modifying Gorday's method as taught by LaPorta, a pagor can send messages to a plurality of devices (e.g., a telephone or a computer), the pagees can respond directly from their devices, and the pagor can receive the responses via his/her pager, thereby eliminating a pagor having to receive a pagee's response via a telephone (see LaPorta, Col. 1, lines 25-30).

Regarding claim 11, as described above in claim 10, Gorday's radio communication system 100 enables PSUs 106 to receive messages from telephones, facsimile machines, and

Art Unit: 2635

messaging terminals, which are devices other than pagers. This is accomplished by Gorday's system controller 102, which (1) receives messages from telephones, facsimile machines, and messaging terminals, (2) encodes the outbound messages intended for PCU 106, (3) stores a queue of the encoded outbound messages in message memory 208, (4) transmits the outbound messages to PSUs 106, and (5) stores the undeliverable outbound messages in message memory 208 (see Fig. 4, steps 408 and 424; Col. 5, lines 11 - 16; Col. 6, lines 24 - 30; and Col. 10, lines 14 - 25 and 46 - 52). Consequently, Gorday's system controller 102 and transmitter/receiver 103 are understood to form a unified messaging system.

Regarding claim 13, Gorday omits teaching the step of system controller 102 receiving from a page sender (i.e., the "originator" or "pagor") at least one of a plurality of predetermined messages that is to be sent to an intended PSU 106.

Per LaPorta, two-way wireless messaging system 10 supports various types of messages, such as pre-canned or predetermined messages (see Col. 13, lines 55 - 67 and Col. 14, lines 1 - 20). Referring to Figs. 7 and 8, LaPorta teaches a sender S 200 sending message PG2BS-NEW, which is one of a plurality of pre-canned messages since user agent UA-S 212 performs the message expansion function prior to forwarding the message messaging server 210 (see Col. 14, lines 60 - 65).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Gorday as taught by LaPorta because the step of transmitting at least one of a plurality of pre-canned messages enables the sender (i.e., "pagor") to send messages with limited input, thereby making message generation easy and practical, especially when the messaging device has little or no input means (see LaPorta, Col. 13, lines 47 - 52).



Regarding claims 17 and 21, Gorday's processing system 204, as shown in Fig. 2, includes a conventional computer system 212 and mass storage media 214, wherein the functions of processing system 204 are executed by computer system 212 and controlled by a set of program instructions stored in mass storage media 214 (see Col. 7, lines 2 - 14 and 22 - 30).

Regarding claim 19, as discussed in claim 6, in order for a user (i.e., "pagee") to respond to an originator's (i.e., "pagor") outbound message via PSU 106, system controller 102 must store information relating to the originator's communication mode that can be used by PSU 106 to send a response to the originator. Consequently, Gorday's method further includes the steps of: (a) system controller 102 (i.e., "the unified messaging system") receiving PSU 106's response to a received outbound message; (b) system controller 102's message handler function identifying the inbound response as having been generated by the user specifically in response to the outbound message and generating another message to be sent to the originator for notifying the originator that the outbound message has been acknowledged and responded to by PSU 106; and (c) system controller 102's message handler function retrieving the originator's communication mode information from memory and routing the new outbound message according to the retrieved information. (See Col. 6, lines 7 - 16 and 35 - 52.)

8. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gorday et al. (US 5,703,570) in view of LaPorta et al. (US 5,974,300) as applied to claim 10 above, and further in view of DeLuca (US 5,258,751).

Gorday and LaPorta are silent that activating the message-waiting indicator comprises activating a sensory indicator, such as a light indicator, an audible indicator, or a tactile indicator.

Art Unit: 2635

In an analogous art, DeLuca's selective call receiver (SCR) 200, as shown in Fig. 2, comprises audible alert 210, visual indicator 211, and tactile alert 212 that function as message-waiting indicators (see Col. 4, lines 42 - 49 and Col. 8, lines 21 - 26). SCR 200 is also able to indicate unread messages via display 208 (see Fig. 7C and Col. 8, lines 26 - 30).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify PSU 106 of Gorday and LaPorta as taught by DeLuca because a PSU 106 having three different types of message-waiting indicators ensure that a user is notified of unread messages.

9. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gorday et al. (US 5,703,570) in view of LaPorta et al. (US 5,974,300) as applied to claim 10 above, and further in view of Kudoh (US 5,726,642).

Gorday and LaPorta are silent that activating the message-waiting indicator comprises activating a sensory indicator.

In an analogous art, Kudoh teaches that alarm portion 10, which constitutes a loudspeaker, performs call alarms (i.e., a new message alarm and a non-read alarm) that are different depending on whether or not there is a non-read message (see Col. 4, lines 28 - 37). Because the ear is a sensory organ, alarm portion 10 is considered to be a sensory indicator.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify PSU 106 of Gorday and LaPorta as taught by Kudoh because a user is able determine presence of unread messages without having to look at PSU 106 if the message-waiting indicator is an alarm portion 10.

*Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clara Yang whose telephone number is (571) 272-3062. The examiner can normally be reached on 8:30 AM - 7:00 PM, Monday - Thursday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2635

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CY

15 August 2005



BRIAN ZIMMERMAN  
PRIMARY EXAMINER